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COPY MAILED

DEC 28 2007

In re Application of :  
Auffret, et al. :  
Application No. 10/601,355 :  
Filed: June 23, 2003 :  
Atty. Dkt. No.: PC22039A :

OFFICE OF PETITIONS

: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "Petition to Adjust Patent Term Adjustment (PTA) Indicated in Notice of Allowance," filed September 20, 2007. This matter is being treated as an application for patent term adjustment under 37 CFR 1.705(b).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby GRANTED.

Applicant requests that the Determination of Patent Term Adjustment be corrected from zero days, as indicated on the Determination of Patent Term Adjustment mailed June 20, 2007, to an adjustment of 116 days. Applicant argues that a response to the final Office action re-mailed April 12, 2007 was timely submitted June 5, 2007.

The correct PTA at the time of the allowance is 116 days, as argued by applicants.

Applicants do not contest the adjustment of 116 days under 37 CFR 1.702(a)(1).

Applicants contest the 217 day reduction under 37 CFR 1.704(b) in connection with the response to the final Office action submitted June 5, 2007.

A review of the record reveals that while a final Office action was mailed July 31, 2006, the final Office action was re-mailed on April 12, 2007. The newly mailed final Office action set a new period of time for reply, making a reply due on or before July 12, 2007. Applicants timely responded to the final Office action on June 5, 2007. Accordingly, the reduction of 217 days has been restored.

In review thereof, at the time of allowance, the application is entitled to an adjustment of 116 days, as argued by applicants.

The required PTA application fee of \$200.00 has been charged to applicant's deposit account as authorized.

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

The application file is being forwarded to the Office of Patent Publications for issuance of a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

*Kery A. Fries*

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure:      Adjusted PAIR Calculation

Day : Thursday  
Date: 12/27/2007

Time: 13:23:20

PALM INTRANET

PTA Calculations for Application: 10/601355					
Application Filing Date:		06/23/2003	PTO Delay (PTO):		116
Issue Date of Patent:			Three Years:		0
Pre-Issue Petitions:		0	Applicant Delay (APPL):		217
Post-Issue Petitions:		0	Total PTA (days):		116
PTO Delay Adjustment:		217			
File Contents History					
Number	Date	Contents Description	PTO	APPL	START
62	12/27/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	217		
54	06/20/2007	MAIL NOTICE OF ALLOWANCE			
53	06/18/2007	ISSUE REVISION COMPLETED			
52	06/18/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
51	06/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
50	06/18/2007	DOCUMENT VERIFICATION			
49	06/18/2007	NOTICE OF ALLOWABILITY			
48	06/13/2007	PARALEGAL TD ACCEPTED			
47	06/05/2007	TERMINAL DISCLAIMER FEE PAID			
46	06/05/2007	TERMINAL DISCLAIMER FILED		0	44
45	06/11/2007	DATE FORWARDED TO EXAMINER			
44	06/05/2007	AMENDMENT AFTER FINAL REJECTION		217	40
43	04/12/2007	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
42	04/10/2007	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
41	02/01/2007	MISCELLANEOUS INCOMING LETTER			
40	07/31/2006	MAIL FINAL REJECTION (PTOL - 326)			
39	07/24/2006	FINAL REJECTION			
38	06/13/2006	DATE FORWARDED TO EXAMINER			
37	06/12/2006	RESPONSE AFTER NON-FINAL ACTION			
36	03/13/2006	MAIL NON-FINAL REJECTION			
35	03/09/2006	NON-FINAL REJECTION			
34	02/08/2006	DATE FORWARDED TO EXAMINER			
33	01/20/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
		REQUEST FOR EXTENSION OF TIME - GRANTED			

32	01/20/2006			
31	11/23/2005	MAIL RESTRICTION REQUIREMENT		
30	11/22/2005	REQUIREMENT FOR RESTRICTION / ELECTION		
29	11/03/2005	CASE DOCKETED TO EXAMINER IN GAU		
28	09/13/2005	DATE FORWARDED TO EXAMINER		
27	09/02/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE		
26	09/13/2005	DATE FORWARDED TO EXAMINER		
25	09/02/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)		
24	09/13/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)		
23	09/02/2005	WORKFLOW - REQUEST FOR RCE - BEGIN		
22	08/31/2005	CASE DOCKETED TO EXAMINER IN GAU		
21	06/02/2005	MAIL FINAL REJECTION (PTOL - 326)		
20	05/31/2005	FINAL REJECTION		
19	03/24/2005	DATE FORWARDED TO EXAMINER		
18	03/11/2005	RESPONSE AFTER NON-FINAL ACTION		
17	12/17/2004	MAIL NON-FINAL REJECTION	116	-1
16	12/10/2004	NON-FINAL REJECTION		
15	01/16/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE		
14	01/16/2004	CASE DOCKETED TO EXAMINER IN GAU		
13.7	09/02/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
13	09/02/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
12	09/02/2003	APPLICATION RETURN FROM OIPE		
11	09/02/2003	APPLICATION RETURN TO OIPE		
10	09/02/2003	APPLICATION RETURN FROM OIPE		
9	09/03/2003	APPLICATION IS NOW COMPLETE		
8	09/02/2003	PRE-EXAM OFFICE ACTION WITHDRAWN		
7	09/02/2003	APPLICATION RETURN TO OIPE		
6	08/28/2003	APPLICATION DISPATCHED FROM OIPE		
5	08/29/2003	APPLICATION IS NOW COMPLETE		
4	08/12/2003	CASE CLASSIFIED BY OIPE		
3	08/12/2003	CLEARED BY OIPE CSR		
2	07/15/2003	IFW SCAN & PACR AUTO SECURITY REVIEW		
1	06/23/2003	INITIAL EXAM TEAM NN		

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Search Another: Application#

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Anthony Auffret et al.  
Ser. No. : 10/601,355  
Filing Date : June 23, 2003  
For : PROCESS FOR CONTROLLING THE HYDRATE MIX OF  
A COMPOUND  
Examiner : Chung, Susannah Lee  
Art Unit : 1626  
Atty. Docket : PC22039A

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Mail Stop: Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Petition to Adjust Patent Term Adjustment (PTA)**

**Indicated in Notice of Allowance**

Sir:

1. This is a request for reconsideration of the patent term adjustment (PTA) of 0 days indicated in the Determination of Patent Term Adjustment Under 35 USC § 154(b) that was attached to the Notice of Allowance mailed on June 19, 2007. It is respectfully requested that a PTA of 116 days be afforded to the present application.
2. The issue fee has not yet been paid.
3. Applicants submit below in Section II a Statement of Facts as required by 37 C.F.R. § 1.705(b)(2). In summary, Applicants disagree with the Office of Petitions that there was a delay associated with Applicants' Response after Final Rejection filed on June 5, 2007. According to the PTO's calculation, 217 days of patent term was deducted between October 31, 2006, three months after the mailing date of the Final Office Action (July 31, 2006), and June 5, 2007, the

filing date of the Amendment after Final Rejection. The PTO calculation obtained from the PAIR website is attached as Exhibit A. But the period for the July 31, 2006 Final Office Action was restarted on April 12, 2007. Specifically, on April 12, 2007 a Final Office Action was issued to replace the Office Action issued July 31, 2006. Thus, the period between July 31, 2006 and June 5, 2007 should not be deducted from the patent term. Further, Applicants filed a response (June 5, 2007) to the Final Office Action (April 12, 2007) within three months of the mailing date, hence, no patent term should be deducted between April 12, 2007 and June 5, 2007 (37 CFR 1.704(b)). Accordingly, the 217 days of patent term debit calculated by the Office of Petitions and associated with Applicants' response dated June 5, 2007 should be zero..

4. The fee set forth in § 1.18(e) (\$200), as required by 37 C.F.R. § 1.705(b)(1), is paid as follows: Please charge deposit account 16-1445 in the amount of \$200.

## **I. Background**

### **A. Summary of relevant Prosecution History**

1. A Notice of Allowance was mailed on June 6, 2007, for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) that indicated that the total PTA to date was 0 days.
2. A Final Rejection mailed July 24, 2006 was undelivered by the U.S. mail, and was returned to sender (see last page of "Mail returned to USPTO as undelivered" dated August 8, 2006 in PAIR).
3. On February 2, 2007 Applicants submitted "Proof of Non-Receipt of the Office Action and Request to Reset the Clock."

4. On April 12, 2007 an Office Action was issued to replace the Office Action issued July 31, 2006 (in essence, withdrawing the July 31, 2006 Office Action) and to restart the clock for the period of response by Applicants.
5. Applicants responded to the April 12, 2007 Office Action on June 5, 2007, within the 3 month period of reply under rule 1.704(b).

**II. Statement of Facts Required by 37 C.F.R. § 1.705(b)(2)(i), (ii), (iii) and (iv)**

**A. 37 C.F.R. § 1.705(b)(2)(i) - Correct PTA and the Basis or Bases under § 1.702 for the Adjustment**

1. The correct total PTA credit is 116 days.
2. The basis for the entire PTA credit of 116 days is under rule 1.702(a)(1) and is due to the delay of the PTO's response (i.e., December 10, 2004) to Applicants' filing date of June 23, 2003.

**B. 37 C.F.R. § 1.705(b)(2)(ii) - Relevant Dates as Specified in §§ 1.703(a) - (e) for Which an Adjustment is Sought and the Adjustment as Specified in § 1.703(f) to Which the Patent Is Entitled**

1. The only relevant dates as specified in rule 1.703(a)(1) for the total PTA credit is Applicants' filing date of June 23, 2003 and the PTO's first response dated December 10, 2004. This results in a patent term credit of 116 days. However, the Office of Petitions incorrectly applied a patent term debit relating to Applicants' Response dated June 5, 2007. However, since this Response was in response to the April 12, 2007 Office Action, under rule 1.704(2), there should be no patent term debit.
2. The total PTA under § 1.703(f) is 116 days, which is the total PTA credit for PTO delay of 116 days less the total PTA debit for applicant delay of 0 days.



**C. 37 C.F.R. § 1.705(b)(2)(iii) - Is Patent Subject To a Terminal Disclaimer**

1. The patent granted on this application is subject to a terminal disclaimer.  
(Attached as Exhibit B). There is no expiration date indicated on the terminal disclaimer.

**D. 37 C.F.R. § 1.705(b)(2)(iv) - Circumstances During the Prosecution of This Application Constituting a Failure to Engage in Reasonable Efforts to Conclude Processing or Examination**

1. There are no circumstances during prosecution by Applicant that constitute a failure to engage in reasonable efforts to conclude processing or examination.

**III. Conclusion**

- A. Applicants submit that the Determination of PTA of 0 days that was attached to the Notice of Allowance mailed on June 6, 2007 is incorrect.
- B. Applicants submit that any delay associated with Applicants' Response dated June 5, 2007, should be calculated based on the Office Action mailed April 12, 2007 and pursuant to rule 1.704(b) and that a PTA of 116 days should be afforded to the present application. The PTA of 116 days results from a total PTA credit of 116 days less PTA debits of 0 days.

Respectfully submitted,

Date: September 20, 2007

/Jason G. Tebbutt/  
Jason G. Tebbutt  
Attorney of Record  
Reg. No. 55,671

Pfizer Inc  
Patent Department